

Appl. No. : 09/284,421
Filed : June 11, 1999

REMARKS

Applicant has the following amendments and remarks in response to the Office Action, mailed February 6, 2006.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 89-94, 96-99, 105, 107, 108, 110-113, 116, 121-123, 125-127, 129-131, and 156-158 under 35 U.S.C. § 103(a) as being unpatentable over WO/96/09548, to Gordon in view of U.S. Patent No. 5,496,520, to Kelton.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicant respectfully submits that the cited references fail to teach or suggest in isolation and in combination at least one limitation from each of the above-listed claims. Furthermore, Applicant respectfully submits that there is no teaching or suggestion to combine the references as suggested by the Examiner.

One embodiment described in the application includes: "an upper substantially planar, rigid surface and a lower closely spaced opposed and substantially planar, rigid surface, said upper and lower surfaces defining a space therebetween, [and] a cavity between the upper surface and the lower surface holding a insert disc having a plurality of separate reaction sites."

Applicant respectfully submits that the cited references do not teach in isolation or in combination at least the foregoing limitation. For example, as may be seen from Figure 6 of Gordon it fails to provide a chamber or cavity to hold an insert disc. Furthermore, this is also not suggested by Kelton. *See e.g.*, Kelton, Figure 3. Since the cited prior art fails to teach or suggest at least one limitation from the cited art, Applicant respectfully submits that the claims are in condition for allowance.

Furthermore, Applicant respectfully submits that there is no teaching or suggestion to modify Gordon and Kelton with other art, such as U.S. Patent No. 5,281,540, Merkh to derive the presently claimed invention. In the Office Action, with respect to Claim 95, the Examiner

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stated that "Based upon the combination of Gordon, Kelton et al, and Merkh et al, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to subdivide the disc assay plate taught by Gordon into removable sectors separated from one another by dividing wall, similar to the configuration of the disc plate taught by Merkh et al, so as to provide means for analyzing a plurality of samples applied to the different sectors at the same time while keeping the sample separated from one another to avoid contamination, thus allowing more test to be run in a given amount of time."

In response, Applicant submits that this finding does not support a prima facie rejection. Applicant respectfully submits that the Examiner can satisfy the burden of showing obviousness of the combination or modification "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998). The fact that references can be modified is not sufficient to establish prima facie obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. *Id.* In this case, Applicant respectfully submits that the Examiner has merely made conclusory findings regarding the motivation to modify the Chang system.

Merkh has a entirely different solution than what is described and suggested by Gordon and Kelton. There is no teaching or suggestion in either reference hinting that the functionality described in the one reference could beneficially be included in the other. Applicant respectfully submits that it is improper to use the claims as a blueprint when determining whether there would have been motivation in the prior art to combine references in a selected fashion. Applicant respectfully submits that the Examiner has selectively picked items from the prior art in hindsight using the benefit of Applicant's claims. Applicant respectfully submits that are innumerable features of different systems that *could* be incorporated into the Gordon; however, such fact does not support that one ordinary skill in the art *would* be motivated to include such

features. Here, there is no common problem amongst the cited references that would motivate their combination.

In fact, even if it were permissible to “pick and choose” from the teachings of Merkh, Applicant’s claimed invention is not made obvious by the combination of Merkh with Gordon and/or Kelton because providing sections would change the principle of operation of Gordon’s and or Kelton’s system. Where the proposed modification of the prior art changes the principle of operation of the prior art invention being modified, the teachings of the references are not sufficient to render the claims *prima facie* obvious.¹ In *Ex parte H. Worth Love*, the Board of Patent and Appeals and Interferences (“Board”) reviewed an Examiner’s rejection under 35 U.S.C. § 103(a).² There the Examiner conceded that a solenoid actuated drain valve—disclosed in U.S. Pat. No. 4,336,832 to Frantz et al. (Frantz)—did not include an electric control circuit for operating the solenoid in real-time.³ In fact, in order to minimize air pressure loss, Frantz provided a control circuit that operated with a time delay.⁴ The Examiner took the position, however, that “if one of ordinary skill in the art is not concerned with the loss or air pressure, he would have found it obvious to eliminate the cycled operation.”⁵ The Board reversed the Examiner’s obviousness rejection stating that “eliminating the cycled operation in Frantz would altogether change the principle of operation of the Frantz drain valve.”⁶

Here, Merkh operates on the principle of diffuse reflectance to read test results from test sites. *See Merkh*, col. 21, lines 25. In contrast, Gordon operates transmitting light *through* the disc. *See e.g.*, Gordon, Figure 3. However, the cartridges of Merkh are made of synthetic plastic materials. Furthermore, Merkh operates by removing waste introducing wash and removing waster material via fluid probe (28). *See col. 7*, lines 54-60. In Merkh, this works because there is no rigid covering surface. In contrast, Kelton has a rigid permanent lid (14) that covers the circular body (20). Gordon entirely fails to teach washing during rotation of the disc. Thus, to

¹ *See In re Ratti*, 123 U.S.P.Q. 349, 352 (C.C.P.A. 1959) (Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency).

² *Ex parte H. Worth Love*, 1999 WL 33263299 (Bd.Pat.App. & Interf.).

³ *Id.* at 2.

⁴ *Id.*

⁵ *Id.*

⁶ *Id.* at 3.

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accommodate the canisters of Merkh with either Gordon or Kelton would require changing the principle of operation of these devices.

In view that the cited references fail to teach or suggest at least one limitation from each of the above-listed claims and that there is insufficient motivation to combine the references as suggested by the Examiner, Applicant respectfully submits that Claims are in condition for allowance.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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Dated: 1/29/2007

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